

Remarks

In view of the following remarks, favorable reconsideration of the outstanding office action is respectfully requested. Claims 1 – 31 remain in this application.

1. § 112 Rejections

The Examiner has rejected claims 1 – 30 under 35 U.S.C. § 112, first paragraph, as lacking enablement. In particular, the Examiner asserts that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate with the in scope with these claims. The Applicants disagree.

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). In this case, the Examiner makes no effort to compare the disclosure with the claims before making his determination that the claims are not enabled. The Examiner merely issues a conclusory statement that asserts that the claims are not enabled without any support whatsoever.

The specification includes a description of all of the method steps required to produce a glass object having a substantially homogeneous index of refraction with substantially no striae, namely, providing doped silica soot particles, spray-drying, dry-pressing, and consolidating. The specification also describes several process steps employed to eliminate the impurities that may possibly result in striae. For example, the specification describes the step of filtering the air during the soot forming process to produce high purity soot. The

specification also refers to the burning of organic impurities after the soot is formed. Further, the specification also describes a process for eliminating inorganic impurities.

Accordingly, the rejection of claims 1 – 30 under 35 U.S.C. § 112, first paragraph, should be withdrawn.

2. § 103 Rejections

A. The Examiner has rejected claims 1 – 7, 14 – 25, 28 and 30 under 35 U.S.C. § 103 as being unpatentable for obviousness over JP 62-27341 to Gotaro et al. (hereinafter Gotaro) in view of U.S. Patent No. 5,244,485 to Hihara et al. (hereinafter Hihara). The Applicants respectfully traverse the rejection because the Examiner has failed to make a prima facie case of obviousness, since he has failed to provide any citations to specific portions of the references.

Claim 1 is directed to a method for forming an optical blank. The method includes the step of providing doped silica soot particles. The doped silica soot particles are spray-dried to form an agglomerate. The agglomerate is dry-pressed to form a green body. The agglomerate is disposed in a press mold during dry-pressing. A rod-like member is not disposed within the press mold during the step of dry-pressing. The green body is consolidated to form a glass object. The glass object is characterized by a substantially homogeneous index of refraction throughout the glass object. The glass object has substantially no striae disposed therein.

Gotaro is directed to a method for making fused glass. The method includes the steps of obtaining glass particles by a vapor chemical reaction, heating and drying the particles, press molding the particles, and finally, sintering the molded glass object.

Hihara is directed to a method of manufacturing a silica glass preform. The method includes the steps of inserting a rod-like member, mainly containing a ductile material, into a forming space of a mold. The remaining space of the forming space is charged with a forming material containing silica glass powder or doped silica glass powder. The mold charged with the forming material is compressed from outside such as to form a porous glass

body of the forming material around the rod-like member. The rod-like member is removed from the porous glass body. A glass rod is inserted into the hole formed after removal of the rod-like member. The porous glass body in which the glass rod is inserted is purified. Finally, the purified porous glass body is consolidated.

According to the **MPEP 2143**, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

1. The prior art references do not teach or suggest all the claim limitations.

Applicants note that the Examiner's Office Action provides a new ground of rejection. The new ground of rejection is a tacit admission that the rejection issued in the first Office Action is not valid. Therefore, the new rejection cannot possibly rely on statements made in the first office action. On its face, the new rejection, which includes the combination of Gotaro and Hihara, does not include any cites to any specific portions of the references. As such, the Examiner does not point out where the combination of references teaches and suggests all of the claim limitations. As such, according to MPEP 2143 and *In re Vaeck*, the Examiner has failed to provide a *prima facie* case of obviousness.

2. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The Examiner asserts that "it would have been obvious to one skilled in the art at the time the invention was made to utilize the specific parameters of Hihara in the process of JP 62-27341 in view of the generic disclosure therein."

The U.S. Court of Appeals for the Federal Circuit has stated that the Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness and in the case of combined references, the Examiner can satisfy this burden “only by showing some objective teaching in the prior art . . . would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). In this case, the Examiner fails to point to even one objective teaching because he does not reference any portion of either reference. The Examiner fails to point to any specific parameters from Hihara. The Examiner also does not explain how such “specific parameters” be incorporated in the “generic” disclosure of Gotaro. The Examiner’s reasons for combining appear to include the Examiner’s own subjective reasons for combining. This, of course, is improper.

Accordingly, the Applicants respectfully assert that claims 1 – 7, 14 – 25, 28 and 30 are patentable under 35 U.S.C. § 103(a).

B. The Examiner has rejected claims 8 – 13, 26 and 29 under 35 U.S.C. § 103 as being unpatentable for obviousness over JP 62-27341 to Gotaro et al. (hereinafter Gotaro) in view of U.S. Patent No. 5,244,485 to Hihara et al. (hereinafter Hihara) as applied to claims 1 – 7, 14 – 25, 28 and 30 above, and further in view of U.S. Patent No. 3,383,172 to Biegler et al. (hereinafter Biegler), U.S. Patent No. 3,301,635 to Bergna et al. (Bergna) or to U.S. Patent No. 4,842,628 to Kreutzer et al. (hereinafter Kreutzer).

As pointed out in Section A.1 above, the Examiner does not point out where the combination of Gotaro and Hihara teach and suggest all of the claim limitations recited in claim 1. The Examiner fails to point out where either Biegler, Bergna, or Kreutzer remedy the deficiencies of claim 1, from which claims 8 – 13, 26 and 29 depend. As such, the Examiner does not make a *prima facie* case of obviousness with respect to claims 8 – 13, 26 and 29, because the Examiner does not show where the combination of Gotaro and Hihara, and Biegler, Bergna, or Kreutzer teach or suggest all of the claim limitations, which include the limitations of claim 1 and any intervening claims.

C. The Examiner has rejected claim 31 under 35 U.S.C. § 103 as being unpatentable for obviousness over JP 62-27341 to Gotaro et al. (hereinafter Gotaro) in view of U.S. Patent

No. 5,244,485 to Hihara et al. (hereinafter Hihara) as applied to claims 1 – 7, 14 – 25, 28 and 30 above, and further in view of U.S. Patent Application 2002/0154280 to Bernas et al. (hereinafter Bernas).

Again, the Examiner does not point out where the combination of Gotaro and Hihara teach and suggest all of the claim limitations recited in claim 1. The Examiner fails to point out where Bernas provides the features that are missing from Gotaro and Hihara with respect to claim 1. Claim 31 depends from claim 1. Accordingly, the Examiner does not make a prima facie case of obviousness with respect to claim 31 because the Examiner does not show where the combination of Gotaro, Hihara, and Bernas teach or suggest all of the claim limitations of claim 31, which include the limitations of claim 1.

3. Conclusion

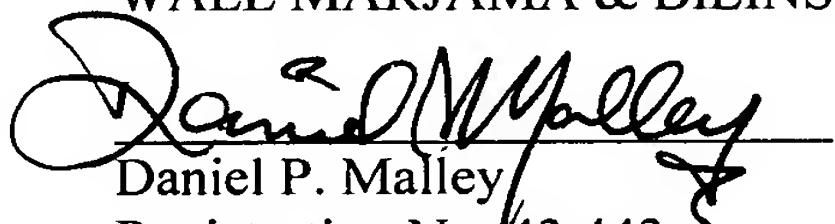
Based upon the above remarks and papers of record, Applicant believes the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicant respectfully requests reconsideration of the pending claims 1 – 31 and a prompt Notice of Allowance thereon.

Applicant believes that no extension of time is necessary to make this Response timely. Should Applicant be in error, Applicant respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.136(a) as necessary to make this Response timely, and hereby authorizes the Office to charge any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 50-0289.

Please direct any questions or comments to Daniel P. Malley at (607) 256-7307.

Respectfully submitted,

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